

Application No. 10/037,446
Amendment dated September 30, 2005
Reply to Office Action of June 30, 2005

Docket No.: 29757/AG75

AMENDMENTS TO THE DRAWINGS

The attached sheets of drawings are identical to the formal drawings submitted on May 21, 2002, that were intended to replace the informal drawings submitting in the original filing on January 2, 2002.

Attachment: Replacement sheets (21 pages)

REMARKS

This paper is filed in response to the Office Action dated June 30, 2005. As this paper is filed on September 30, 2005, the paper is timely filed.

I. Status of Amendments

Claims 1-17 were pending prior to this amendment with claims 18-55 withdrawn. By this amendment, applicant amends claims 1, 3, 4, 9, and 13-16, and cancels claims 24-43 without prejudice to refile. Thus, claims 1-23 and 44-55 are now pending, with claims 18-23 and 44-55 withdrawn.

II. Response to Office Action

A. General Comments

Although the application describes various embodiments and makes various statements regarding the “invention,” it is well settled that the legal scope of the invention is defined by the words of the claims and that it is improper to read features of the embodiments described in the specification into the claims. It should also be recognized that the term “invention” may be used to mean various different things.¹ For example, the term “invention” may be used to refer to the technical subject matter that has been invented; the term “invention” may be used to refer to subject matter which is nonobvious; and the term “invention” may be used to refer to subject matter defined by the claims of a patent. Thus, the mere fact that the present application uses the term “invention” in various statements does not mean that the scope of the claims is limited by such statements.

¹ This is explained in the Glossary of Volume 1 of Chisum on Patents, where the term “invention” is defined as follows:

INVENTION – In patent law, the word ‘invention’ has several different meanings. It may refer to (1) the act of invention through original conception and reduction to practice; (2) subject matter described and/or claimed in a patent, patent application or prior art reference (e.g., a product or process); or (3) the patentability requirement of invention, first developed by the courts and now subsumed in the statutory requirement of nonobviousness. Thus, an applicant may have invented (1) an invention (2) which is unpatentable for lack of invention (3) because it is an obvious modification of an invention (2) used by others in this country before the invention (1) thereof by the applicant.

It should also be understood that, unless a term is expressly defined in the application using the sentence "As used herein, the term '_____ ' is hereby defined to mean..." or a similar sentence, there is no intent to limit the meaning of that term, either expressly or by implication, beyond its plain or ordinary meaning, and such term should not be interpreted to be limited in scope based on any statement made in any section of the present application (other than the language of the claims). Finally, unless a claim element is defined by recital of the word "means" and a function without the recital of any structure, it is not intended that the scope of any claim element be interpreted based on the application of 35 U.S.C. § 112, sixth paragraph.

It is respectfully submitted that the foregoing comments regarding claim construction are consistent with 35 U.S.C. §112 and the Office practice of utilizing the "broadest reasonable interpretation" of claims.

It is also respectfully submitted that the claims are supported by the application, that the claims satisfy the written description requirement and the other requirements of 35 U.S.C. §112, and that no new matter is being added. In this regard, it is well settled that the specification need not reproduce the exact language of the claims to satisfy the written description requirement of §112, first paragraph. In re Wright, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) ("[T]he claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement."). The written description requirement of §112 can even be satisfied based solely on the drawings of a patent application. Vas-Cath Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991) ("These cases support our holding that, under proper circumstances, drawings alone may provide a 'written description' of an invention as required by §112").

B. The June 30 Office Action

In the June 30 Office Action, the drawings were objected to and reference was made to an attached Notice of Draftperson's Patent Drawing Review, however, no Notice was found in the Office Action, as indicated on page 3. The applicant's agent spoke with the examiner indicating formal drawings had been submitted on May 21, 2002. To ensure responsiveness, replacement drawings are attached with the words "Replacement Sheet" in

the top margin, pursuant to 37 CFR § 1.121(d). The applicant requests the objection to the drawings be withdrawn.

Also, claims 1 and 2 were rejected under 35 U.S.C. §102(e) as allegedly anticipated by Webb et al. (United States Patent No. 6,461,241), and claims 3-15 were rejected under 35 USC § 103(a) as allegedly unpatentable over Webb in view of the game Pente. On the other hand, claims 16 and 17 were objected to as being dependent upon a rejected claim, but were indicated to be allowable if rewritten in independent form.

By this amendment, the applicant has rewritten claim 16 in independent form to include the limitations of original claim 1. Thus, claim 16 and its dependent claim, claim 17, should now be allowable.

Additionally, claim 1 has been amended to recite, in part, a gaming system comprising a primary game and a networked secondary game of mental strategy between two or more gamers. The amendment is supported by, at least, paragraphs [0086], [0089], and [0098] and Fig. 12. No new matter has been added.

Webb does not disclose, teach, or suggest a networked secondary game of mental strategy between two or more gamers as recited in amended claim 1. Instead, Webb states (at Col. 6, line 34) that “the player competes against the gaming device.” The Pente reference does not disclose, teach or suggest a primary or a secondary game, as claimed. To the extent Pente suggests a board game played by two people, applicant submits that even if Pente were combined with Webb (an argument the applicant does not concede) Webb’s statements related to a competition between a computer and a player cannot be replaced by Pente’s statements regarding a board game playable between two players. This is especially true as the Pente reference provides no disclosure as to how such a multi-player game might be established in the environment of Webb, and neither does Webb.

Because neither Webb nor Pente disclose, teach, or suggest the limitation of a networked secondary game of mental strategy between two or more gamers, they do not disclose, teach or suggest each limitation of amended claim 1, either separately or in combination. Therefore, claim 1 is allowable over the cited art. Moreover, claims 2-15 are

also allowable at least because they depend directly or indirectly from amended claim 1. The applicant requests the rejection of claims 1-15 be withdrawn.

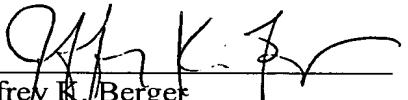
C. The Supplemental Information Disclosure Statement

Applicant files herewith a Supplemental Information Disclosure Statement. In the Supplemental Information Disclosure Statement, applicant cites U.S. Patent Application 10/027,888 (US 20030114218) filed December 19, 2001, U.S. Patent Application 10/029,381 (US 20030114219) filed December 19, 2001, and U.S. Patent Application 10/029,379 (US 20030119581) filed December 20, 2001. Accompanying the Supplemental Information Disclosure Statement is the fee set forth for filing such an IDS after receipt of the first Office Action.

In view of the foregoing, it is respectfully submitted that the above application is in condition for allowance, and reconsideration is respectfully requested. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

Dated: September 30, 2005

Respectfully submitted,

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REPLACEMENT SHEETS